



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,110	09/17/2003	Christopher R. Gentle	4366-155	8515

48500 7590 10/09/2007
SHERIDAN ROSS P.C.
1560 BROADWAY, SUITE 1200
DENVER, CO 80202

EXAMINER

TRAN, TUYETLIEN T

ART UNIT	PAPER NUMBER
----------	--------------

2179

MAIL DATE	DELIVERY MODE
-----------	---------------

10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/667,110	Applicant(s) GENTLE, CHRISTOPHER R.	
	Examiner TuyetLien (Lien) T. Tran	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-23 and 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/24/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the following communication: Amendment filed 8/09/07.

This action is made non-final.

2. Claims 1-7, 9-23 and 25-35 are pending in the case. Claims 1, 17, 31 and 34 are independent claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/09/07 has been entered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (Patent No. 5995101; hereinafter Clark).**

As to claim 31, Clark teaches:

An apparatus for displaying a consequence of a selection to a user (e.g., computer system 10 for displaying a multi-level tool tip, see Fig. 3 and Fig. 5), comprising:

Art Unit: 2179

means for visually displaying (e.g., display device 28 in Fig. 5);

means for receiving user input (e.g., I/O bus 26, I/O interface 27, keyboard 29, mouse 34, see Fig. 5);

means for determining a position of a cursor (e.g., see step 100 in Fig. 4), wherein said cursor is displayed by said means for visually displaying (e.g., see cursor 52 in Fig. 3) and is responsive to said means for receiving user input (e.g., see col. 1 lines 44-53);

means for determining a relationship between a position of a selectable item displayed by said means for visually displaying and said cursor (e.g., see Fig. 3); and

means for generating a depiction of a consequence of selecting said selectable item at least when said cursor is within an area occupied by said selectable item on said means for visually displaying (e.g., see Fig. 3; note that the third-level tool tip may provide a graphical image 64 demonstrating the icon's function in detail; further note that the program may include as many additional, higher-level tips as needed to fully demonstrate the program function associated with the icon 54, see e.g., col. 2 lines 51-63).

wherein said selectable item is associated with an application program (e.g., the multi-level tool tip involves providing information in a graphical display about a particular function of a program executing on a computer system, see col. 1 lines 43-50); although the disclose invention does not expressly show that selectable item performs an operation and that the operation does not include opening a file, it would have been obvious to one skilled in the art at the time the invention was made to realize that the tool bar items shown in the application window in Figs. 1-3 is for performing an operation on a file that is open within the application window; that is the operation does not include opening a file because Clark suggests to the skilled artisan that the disclose invention can be applied for any control area in a graphical user interface including those that shown in Adobe's web page authoring product (e.g., see Figs. 1-3

Art Unit: 2179

and col. 3 lines 63-67). The motivation is to provide much insight into the functions of the related icons or selectable items (e.g., see Clark col. 1 lines 34-40).

As to claim 34, Clark teaches:

An apparatus for providing a depiction of the consequences of making a selection (e.g., computer system 10 for displaying a multi-level tool tip, see Fig. 3 and Fig. 5), comprising:

data storage (e.g., RAM 21, ROM 22, hard disk 33, see Fig. 5 and col. 5 lines 14-25), wherein at least a first application is maintained in said data storage (e.g., program 15 is stored in hard disk 33, see Fig. 5);

a data processor operable to execute instructions included in said first application (e.g., CPU 20, see Fig. 5 and col. 5 lines 14-46);

a visual display operable to display graphical elements generated in connection with said execution of said instructions included in said first application and operable to display a cursor (e.g., see Fig. 3);

a pointing device operable to receive commands from a user concerning a position of said cursor with respect to said graphical elements (e.g., see step 100 in Fig. 4), wherein a depiction of the consequences of selecting at least a first selectable item included in said graphical elements is displayed in response to detecting that said cursor is hovering over said at least a first selectable item (e.g., see Fig. 3; note that the third-level tool tip may provide a graphical image 64 demonstrating the icon's function in detail; further note that the program may include as many additional, higher-level tips as needed to fully demonstrate the program function associated with the icon 54, see e.g., col. 2 lines 51-63);

Although the disclose invention does not expressly show that the consequences of selection said at least a first selectable item do not include opening a file, it would have been

Art Unit: 2179

obvious to one skilled in the art at the time the invention was made to implement this limitation for the same reasons as discussed with respect to claim 31 above.

As to claim 32, Clark further teaches displaying the tool tip as a transparent overlay wherein said transparent overlay comprises an alpha-blended rendering (e.g., see Fig. 3).

As to claim 33, Clark further teaches wherein said means for receiving user input comprises a pointing device (e.g., a mouse 34 in Fig. 5).

As to claim 35, Clark further teaches wherein said pointing device includes a button for receiving an indication of a user selection (e.g., left button or right button of a mouse 34 in Fig. 5), and wherein said depiction of the consequences of selecting a selectable item is displayed in the absence of operation of said button (e.g., note that the tool tip is displayed if the user points with a pointing device to an area of the graphical display associated with a function, see col. 1 lines 44-53).

6. Claims 1-15, 17-23, 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Sommerer et al (Pub No. US 2004/0205514 A1; hereinafter Sommerer).

As to claim 1, Clark teaches:

A method for providing a visual representation of the consequences of taking an action (e.g., multi-level tool tip, see Fig. 3), comprising:

first moving a cursor in response to input from a user (e.g., see col. 1 lines 44-53);

first detecting a position of said cursor within an application window (e.g., see step 100 in Fig. 4); and

in response to said position of said cursor corresponding to a first selectable item within said application window, displaying a depiction of a consequence of selecting said first selectable item (e.g., see Fig. 3; note that the third-level tool tip may provide a graphical image 64 demonstrating the icon's function in detail; further note that the program may include as many additional, higher-level tips as needed to fully demonstrate the program function associated with the icon 54, see e.g., col. 2 lines 51-63), wherein said first selectable item is not a representation of a file (e.g., see Figs. 1-3; note that the selectable item is from a tool bar icon);

Although the disclose invention does not expressly show that said consequence of selecting said first selectable item includes an operation that is performed on a file that is open in a computer program presenting said first selectable item, it would have been obvious to one skilled in the art at the time the invention was made to realize the tool bar items shown in the application window in Figs. 1-3 is for performing an operation on a file that is open within the application window because Clark suggests that the disclose invention can be applied for any control area in a graphical user interface including those that shown in Adobe's web page authoring product (e.g., see Figs. 1-3 and col. 3 lines 63-67). It would have been motivated for a skilled artisan to implement this limitation for the same reasons as discussed with respect to claim 31 above

However, Clark does not expressly teach said display includes a preview of a consequence of selecting a selectable item.

Sommerer, though, teaches a hyperlink preview utility that discerns user intent to display a preview of a target resource page associated with a linking control, such as a hyperlink or visit node; wherein the preview is displayed adjacent to the linking control and may display layout and content information to a user; wherein invocation of a hyperlink preview is accomplished by

Art Unit: 2179

hovering over a hyperlink, in a manner similar to the operation for invoking a tool tip; wherein the display includes a preview of a consequence of selecting a selectable item (e.g., see [0008] and Fig. 1).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the function of displaying a hyperlink preview utility as taught by Sommerer to the method of providing a visual representation of the consequences of taking an action as taught by Clark for the purpose of displaying information relating to a selectable item and the motivation for the combination would be to provide a user with information concerning what a graphical representation represents or what is contained within the representation without actually selecting a function (e.g., see Sommerer [0008]).

As to claim 17, Clark teaches:

A computer implemented method (e.g., multi-level tool tip, see Fig. 3), comprising:
determining a position of a cursor (e.g., see step 100 in Fig. 4); and
in response to said position of said cursor hovering over a first selectable item,
displaying a consequence of selecting said first selectable item (e.g., see Fig. 3; note that the third-level tool tip may provide a graphical image 64 demonstrating the icon's function in detail; further note that the program may include as many additional, higher-level tips as needed to fully demonstrate the program function associated with the icon 54, see e.g., col. 2 lines 51-63);
wherein a selection of said first selectable item performs an operation on a file that is open within an application that provides said first selectable item (e.g., note that although Figs. 1-3 display here do not show any content, those skilled in the art would understand that the tool bar items shown in the application window in Figs. 1-3 is for performing an operation on a file that is open within the application window because Clark suggests that the disclose invention can be applied for any control area in a graphical user interface including those that shown in Adobe's

Art Unit: 2179

web page authoring product, see Figs. 1-3 and col. 3 lines 63-67). However, Clark does not expressly teach said display includes a preview of a consequence of selecting said first selectable item.

Sommerer, though, teaches a hyperlink preview utility that discerns user intent to display a preview of a target resource page associated with a linking control, such as a hyperlink or visit node; wherein the preview is displayed adjacent to the linking control and may display layout and content information to a user; wherein invocation of a hyperlink preview is accomplished by hovering over a hyperlink, in a manner similar to the operation for invoking a tool tip; wherein the display includes a preview of a consequence of selecting a selectable item (e.g., see [0008] and Fig. 1). Thus, combining Clark with Sommerer would meet the claimed limitations for the same reasons as discussed with respect to claim 1 above.

As to claims 2 and 18, Clark further teaches:

second moving a cursor in response to input from a user (e.g., moves the cursor to another icon, see col. 3 lines 36-51);

second detecting a position of said cursor (e.g., see step 100 in Fig. 4 and col. 3 lines 36-51); and

in response to said position of said cursor no longer corresponding - or hovering over - to said first selectable item within said application window, discontinuing said displaying a depiction of a consequence of selecting said first selectable item (e.g., see col. 3 lines 36-51).

As to claim 3, Clark further teaches:

second moving a cursor in response to input from said user (e.g., moves the cursor to another icon, see col. 3 lines 36-51);

Art Unit: 2179

second detecting a position of said cursor within said application window (e.g., see step 100 in Fig. 4 and col. 3 lines 36-51); and

in response to said position of said cursor corresponding to a second selectable item within said application window, displaying a consequence of selecting said second selectable item (e.g., see col. 3 lines 36-51).

As to claim 4, Clark further teaches displaying a tool tip of a selectable item in a way that is visually altered as compared to a display in response to an actual selection of said selectable item (e.g., a user cannot interact with the information included in a tool tip while a user can interact with a display of an actual selection of the selectable item, see Fig. 3 and col. 1 lines 11-35). Clark does not expressly disclose that displaying a result of selecting a selectable item. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the step of displaying a result of selecting a selectable item that is different from a display of an actual result of selecting a selectable item, in view of Clark, because Clark suggests to the skilled artisan that the third-level tip 62 may include a graphical image 64 demonstrating the icon's function (e.g., see col. 2 lines 51-63) and that multiple levels of multi-level tool tip may be used to provide different types of information (see col. 5 lines 50-60). The motivation would be to provide much insight into the functions of the related icons or function or to fully demonstrate the program function associated with the selected icon (see col. 1 lines 34-40 and col. 2 lines 51-63).

As to claims 5-6, 21, Clark further teaches displaying the tool tip as a transparent overlay wherein said transparent overlay comprises an alpha-blended rendering (e.g., see Fig. 3).

Art Unit: 2179

As to claims 7 and 22, Clark further teaches displaying the tool tip as a stencil outline (e.g., see Fig. 3).

As to claims 9 and 28, Clark further teaches wherein said hovering over a first selectable item comprises said cursor remaining in an area corresponding to said first selectable item for at least a first predetermined period of time (e.g., see col. 2 lines 30-67);

As to claim 10, Clark further teaches wherein said selectable item comprises at least one of a menu item, an icon, and a button (e.g., icon 54 as shown in Fig. 3).

As to claim 11, Clark further teaches detecting a selection of said first selectable item; in response to said detecting a selection said first selectable item, displaying a consequence of selecting said first selectable item, wherein an appearance of said depiction of a consequence of selecting said selectable item is different than an appearance of said consequence of selecting said selectable item (e.g., see Fig. 3 and col. 1 lines 11-33).

As to claim 12, Clark further teaches wherein said method is performed with respect to a graphical user interface (e.g., see Fig. 3).

As to claim 13, Sommerer further teaches wherein said displayed depiction comprises a depiction of at least one of a submenu or sub-window (e.g., see Fig. 1).

As to claim 14, Clark further teaches after said displaying a depiction of a consequence of selecting said selectable item, in response to a position of said cursor no longer corresponding to said selectable item, discontinuing said displaying a depiction of a consequence of selecting said selectable item (e.g., see col. 3 lines 36-51).

As to claim 15, Clark further teaches displaying an indication of a relationship between said selectable item and said depiction of a consequence of selecting said selectable item (e.g., see Fig. 3).

As to claim 19, Clark further teaches wherein said discontinuing is performed in the absence of a user selection of a second selectable item for discontinuing said depicting a consequence of selecting said first selectable item (e.g., see col. 3 lines 36-51);

As to claim 20, Clark further teaches third determining a position of said cursor; and in response to said position of said cursor hovering over a second selectable item, depicting a consequence of selecting said second selectable item (e.g., see step 100 in Fig. 4 and col. 3 lines 36-51).

As to claim 23, Clark further teaches wherein said depicted consequence of selecting a first selectable item comprises displaying at least one of an inactive submenu, an inactive window, and an inactive dialogue (e.g., a tool tip may be in a containing window, see col. 5 lines 50-60).

As to claim 25, Clark teaches the limitations of claim 17 for the same reasons as discussed with respect to claim 17 above. Clark does not expressly teach that depicting a consequence of selecting said first selectable item comprises a submenu. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the step of displaying a depiction of a submenu, in view of Clark, because Clark suggests to the skilled artisan that the third-level tip 62 may include a graphical image 64 demonstrating the icon's function (e.g., see col. 2 lines 51-63) and that multiple levels of multi-

Art Unit: 2179

level tool tip may be used to provide different types of information (see col. 5 lines 50-60). The motivation would be the same as discussed with respect to claim 4 above.

As to claim 26, Clark further teaches wherein said consequence of selecting said first selectable item comprises a subwindow (e.g., a tool tip may be in a containing window and that selecting a 'user option' control may invoke a dialog, menu, see col. 5 lines 50-60 and col. 4 lines 14-20).

As to claim 27, Clark further teaches in response to a selection of said first selectable item, displaying at least one of an active submenu and an active window (e.g., dialog, menu, etc. see col. 4 lines 14-20 and col. 1 lines 20-30).

As to claim 29, Clark further teaches wherein said computational component comprises a computer readable storage medium containing instructions for performing the method (e.g., RAM 21, ROM 22, hard disk 33, see Fig. 5 and col. 5 lines 14-25).

As to claim 30, Clark further teaches wherein said computational component comprises a logic circuit (e.g., see Fig. 5).

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Sommerer further in view of Mander et al (Patent No. US 6243724 B1; hereinafter Mander).

As to claim 16, Clark and Sommerer teach the limitations of claim 15 for the same reasons as discussed with respect to claim 15 above. Clark and Sommerer do not expressly teach displaying a projection line to show a relationship between a selectable item and a depiction. Mander, though, teaches wherein the indication of a relationship between a

Art Unit: 2179

selectable item and a depiction of a consequence of selecting a selectable item comprises a projection line (e.g., see Fig. 22e). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Clark and Sommerer to incorporate the viewing cone as taught by Mander for the purpose of displaying information relating to a selectable item and the motivation for the combination would be to provide a user with information concerning what a graphical representation represents or what is contained within the representation without actually selecting a function (e.g., see Mander Fig. 4e).

Response to Arguments

8. Applicant's arguments with respect to claims 1-7, 9-23 and 25-35 have been considered but are not persuasive.

♦ In response to applicant's argument that there is no suggestion or motivation to combine the references and that the cited prior art or Clark and Sommerer do not teach or suggest all the limitations of the claims (e.g., see Applicant's remark page 10, paragraph 2 and page 11 paragraph 2), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In addition, the examiner would like to point out that the question under 35 U.S.C. 103 is not merely what the references expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made." *In re Lamberti*, 545 F.2d 747, 750,

Art Unit: 2179

192 USPQ 278, 280 (CCPA 1976). And "Analysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007) quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006); Also, as clarified in KSR, it's now apparent "obvious to try" may be an appropriate test in more situations than previously contemplated. KSR, 127 S. Ct. 1727 at 1742, 82 USPQ2d at 1397 (2007).

In this case, the prior art of Clark teaches all the limitations with regard to claim 1 as addressed supra, however, the examiner then admits that the prior art of Clark does not expressly teach that said consequence of selecting said first selectable item includes an operation that is performed on a file that is open in a computer program presenting said first selectable item, it would have been obvious to one skilled in the art at the time the invention was made to realize the tool bar items shown in the application window in Figs. 1-3 is for performing an operation on a file that is open within the application window because Clark suggests that the disclose invention can be applied for any control area in a graphical user interface including those that shown in Adobe's web page authoring product (e.g., see Figs. 1-3 and col. 3 lines 63-67). It would have been motivated for a skilled artisan to provide much insight into the functions of the related icons or selectable items (e.g., see Clark col. 1 lines 34-40).

The examiner then further admits that the prior art of Clark does not expressly teach said display includes a preview of a consequence of selecting said first selectable item.

Sommerer, though, teaches a hyperlink preview utility that discerns user intent to display a preview of a target resource page associated with a linking control, such as a hyperlink or visit node; wherein the preview is displayed adjacent to the linking control and may display layout

Art Unit: 2179

and content information to a user; wherein invocation of a hyperlink preview is accomplished by hovering over a hyperlink, in a manner similar to the operation for invoking a tool tip; wherein the display includes a preview of a consequence of selecting a selectable item (e.g., see [0008] and Fig. 1).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the function of displaying a hyperlink preview utility as taught by Sommerer to the method of providing a visual representation of the consequences of taking an action as taught by Clark for the purpose of displaying information relating to a selectable item and the motivation for the combination would be to provide a user with information concerning what a graphical representation represents or what is contained within the representation without actually selecting a function (e.g., see Sommerer [0008]).

- ◆ The Applicant argues with respect to claim 1 that the cited prior art of Clark does not teach, suggest or describe the limitation of providing a preview of the actual consequence of selecting an item (e.g., see Applicant's remark page 11 lines 22 through page 12 lines 1-3).

The examiner would like to point out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the features upon which applicant relies (i.e., actual consequence) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- ◆ The Applicant argues that the cited prior art of Sommerer does not teach, suggest or describe the limitation of previewing a consequence of an operation performed on a file that is

Art Unit: 2179

open in a computer program presenting an item that can be selected to perform the operation (e.g., see Applicant's remark page 12, Paragraph 2).

The examiner would like to point out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, the prior art of Clark teaches displaying a high-level tool tip including a graphical image demonstrating the icon's function in detail and that the tool tip can include many additional tips as needed to fully demonstrate the function of the selectable item (e.g., see col. 2 lines 51-63). The prior art of Clark further suggests to a skilled artisan that the disclose invention can be applied for any control area in a graphical user interface including those that shown in Adobe's web page authoring product (e.g., see Figs. 1-3 and col. 3 lines 63-67). However, the examiner admits that the prior art of Clark does not teach a preview of a consequence of selecting said first selectable item. The prior art of Sommerer teaches, though, a hyperlink preview utility that discerns user intent to display a preview of a target resource page associated with a linking control, such as a hyperlink or visit node; wherein the preview is displayed adjacent to the linking control and may display layout and content information to a user; wherein invocation of a hyperlink preview is accomplished by hovering over a hyperlink, in a manner similar to the operation for invoking a tool tip; wherein the display includes a preview of a consequence of selecting a selectable item (e.g., see [0008] and Fig. 1). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the function of displaying a hyperlink preview utility as taught by Sommerer to the method of providing a visual representation of the consequences of taking an action as taught by Clark for the purpose of displaying information relating to a selectable item and the

Art Unit: 2179

motivation for the combination would be to provide a user with information concerning what a graphical representation represents or what is contained within the representation without actually selecting a function (e.g., see Sommerer [0008]).

♦ The Applicant argues that the cited prior art of Mander does not teach, suggest or describe the limitation of the consequence of selecting an item other than an item representing a document or other file (e.g., see Applicant's remark page 12, Paragraph 2).

The examiner would like to point out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action.

It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TuyetLien (Lien) T. Tran whose telephone number is 571-270-1033. The examiner can normally be reached on Mon-Friday: 7:30 - 5:00, off on alternating Friday.

Art Unit: 2179

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

T.T
10/03/2007

Lien Tran
Examiner
Art Unit 2179


BAHUYNH
PRIMARY EXAMINER